

REMARKS/ARGUMENTS

Status:

In the Final Office Action dated December 8, 2008, the status was indicated as:

- 1) claims 1-42 and 44-130 were pending;
- 2) in response to a prior election requirement and Applicant's response, claims 40-53, 70-72, 107-116, and 121-124 were examined in the Office Action; and
- 3) claims 40-42, 44-53, 107 -116 and 121-124 were rejected as obvious under 35 U.S.C. 103(a) as being unpatentable over Borelli et al. (US Patent Application Publication 2006/0020525), herein "Borelli," in view of Tamura (US Patent Application Publication 2003/0048380), herein "Tamura."

Claim Amendments

Claim 51 is amended to provide proper antecedent basis for the limitation "user."

Arguments

Applicant respectfully requests reconsideration of the Final rejection of the above claims in light of the arguments below based, which are largely based on reasons provided in the prior Response and further clarifications thereof.

Applicant addresses initially the "Response to Arguments" in the Office Action, in the same order presented therein.

1(a) The Office Action states:

In response to applicant's argument (Remarks pg. 42 para. 1 to pg. 43 para. 2) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the network service provider adapting for a particular set top box) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See

In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

1(b) Applicant Response:

Applicant is unclear as to the reasoning put forth above, and requests clarification in order to respond in a meaningful manner.

In the prior response, Applicant was attempting to explain operation of the prior art (Tamura) by quoting and discuss paragraph 27 of the prior art, which the Examiner alleged as disclosing the limitations of claim 43.

The allegation in the Office Action that “Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims” implies that the Examiner is under the impression that the Applicant was attempting to use the specification of the prior art to interpret the claims of the present Application. This is not the case, and clearly there is a misunderstanding by the Examiner or a misunderstanding of the Examiner’s statement in the OA.

One of Applicant’s argument is that the prior art section cited by the Examiner appears to disclose communication between the Set Top Box and the Service Provider. However, claim 40 recites communication between the ISPG and ESS. Specifically, claim 40 recites “...the ISPG capable of generating a second provisioning message... an ESS...receiving said second provisioning message....” Thus, the prior art discloses sending information to the set top box, but that is inapplicable to the claim limitations at hand. Claim 40 recites the ISPG is “configured to provide cable service options to the computer” (used by a user), hence the ISPG is clearly not a set top box. Further, the “ESS us[es] said host identifier to ascertain a host file...the host file uses to identify a host protocol file used for generating a message for provisioning a host...” Clearly, neither the ISPG nor the ESS is a host. Thus, communication is between the ISPG and ESS, and neither is a set top box, so the prior art disclosure of communication between a service provider and set top box does not render obvious claim 40.

Applicant submits that with this clarification of the previous argument, it is clear that the prior art does not render obvious claim 40, as well as claims 41-40.

2(a) The Office Action states:

In response to applicant's argument (Remarks pg. 44 para. 2) that Borelli does not select a particular service provider using the user's host type as a basis, the examiner respectfully disagrees. Borelli clearly teaches scanning the client device to determine physical attributes of the machine and using these attributes as a basis for service provider selection ([0038] and [0040]). Furthermore, because Borelli discloses a service provider is selected based on the user's host information there must be a database relating the host with services.

2(b) Applicant Response:

Applicant respectfully requests further details where in paragraphs 38 and 40 Borelli discloses "using these attributes as a basis for service provider selection." Paragraph 38 discloses a customer at a computer may software "which may be provided by a Network provider or ISP" to qualify a user. Then, the software package scans the PC to gather information and "[t]he software package then makes a connection to the provider's order entry system...." Borelli discloses "a Network provider or ISP" providing the software and the software connecting to the "provider's order entry system." **This does not disclose selecting a service provider. Rather only a single service provider is indicated.** Furthermore, it would be illogical to assume that an ISP or Network provider furnishes software for people to load on their computer that would sign up customer for other service providers. Borelli discloses that the software connects "to the provider's order entry system", which is what would be expected. Thus, this disclosure of Borelli suggest a single service provider.

Further, paragraph 40 discloses a single provider, e.g., "[f]or data services over an HFC network, each location capable of connecting to this network may be stored in a database.... The database is populated and maintained by a Network Provider...." (Emphasis added). Again, this supports Applicant's position that the cited portion of Borelli does not disclose selecting a service provider.

Further, the Examiner's statement that "because Borelli discloses a service provider is selected based on the user's host information there must be a database relating the host with

services” is only conjecture (OA, page. 2). The Examiner has conjectured there must be a database, which is not inherent with Borelli’s disclosure, and further bases this assumption on a conclusion which is not supported in the sections as alleged.

Applicant submits that the rejection is not proper, as the cited portions of Borelli do not disclose the limitations as alleged, namely, “selecting a cable service provider” nor the serviceability “database” found in claim 51, and claims 52-53.

3(a) The Office Action states:

In response to applicant’s argument (Remarks pg. 44 para. 3) that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., the network will adapt so as to communicate properly with the set top box) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3(b) Applicant Response:

Since the Examiner has alleged Tamura discloses certain limitations, it is appropriate to review Tamura and understand what it discloses. Consequently, Applicant previously attempted to explain how the prior art (Tamura) operates.

Applicant did previously state:

Claim 51 also recites various limitations involving “host type identifier,” such as:

- “wherein said service related input data comprises an indication of the user’s host type, the ISPG configured to generate a first provisioning message having a first format including the cable subscriber location data and said indication of the user’s host type”, and
- “selecting a cable service provider identifier compatible with said subscriber location data and said indication of the user’s host type, the serviceability database further capable of generating a second provisioning message including at-service related input data and at least one associated host type identifier.”

The above limitations recite the role of the “indication of the user’s host type” in provisioning the host. Specifically, the information of the user’s

host type is indicated and used to ascertain what service provider is compatible with the user's host type.

Applicant submits that the prior response listed specific limitations in the claim. Further, the allegation that Applicant has imported limitations into the claims based on the specification is inaccurate – the recited claim limitations speak for themselves.

Applicant submits the response in the Office Action has not substantively addressed the argument presented. Namely, that Borelli does not disclose using the host type information to select a particular service provider (see, item I(a) and I(b) above). Further, Tamura discloses the service provider sending “system information required by the STB in order [to] properly communicate with the service provider when operational.” Tamura clearly discloses sending information to the STB so that the STB can properly communicate with the service provider. The Examiner has not disputed this point. If Tamura operates in this manner, then the service provider is not compatible with the STB, or at least not until the information is provided to the STB. However, the claim recites “the serviceability database capable of... selecting a cable service provider identifier compatible with ...said indication of the user's host type.” There is no evidence cited that selection of a service provider takes into account whether it is compatible with the user's host type.

4(a) The Office Action states:

In response to applicant's argument (Remarks pg. 44 para. 5 to pg. 45 para. 1) that the combination of Tamura does not disclose receiving the host type information from a computer but rather from a set top box, the examiner respectfully disagrees. Tamura clearly teaches the STB 104 comprises a processor executing program steps stored in a memory ([0022] and [0033]).

4(b) Applicant Response:

Applicant provides additional explanation as to why Tamura does not disclose the claim limitation. Applicant does not dispute that Tamura teaches the “STB 104 comprises a processor executing program steps stored in a memory.” However, there are other limitations recited in

Claim 51 which clearly distinguish the “computer” recited in the claim, and the STB box disclosed in Tamura.

Recall that claim 51 recites the ISPG hosting a web site configured to receive “service related input data from a cable subscriber at a computer connected to the Internet.” Tamura discloses a STB connected to a cable headend (see, e.g., par. 3, 5, Fig. 1). Although it is possible for users to access the Internet using a cable network, Applicant submits that the STP accessing the headend does not mean that Tamura discloses a “computer connected to the Internet” and that the headend is an ISPG hosting a web site. It is well known that STBs are programmed processors for specific functions (cable television reception) and that one of ordinary skill in the art would not consider a STB accessing a headend to be a “computer connected to the Internet” with the headend being a “web site.”

Further, the claim recites the ISPG is configured to “provide cable service options to be displayed on the computer.” If the processor in the STB is alleged to be the “computer”, then Applicant submits there is not any disclosure in Tamura of “cable service options to be displayed.” While Tamura discloses certain information may be displayed to the user, “cable service options” is not one of them (see, e.g., Tamura, FIG. 5, par. 31).

5(a) The Office Action states:

In response to applicant's argument (Remarks pg. 45 para. 3 to pg. 46 para. 3) that Borelli does not disclose generating a host-specific configuration message based on a host protocol file associated with a host type, the examiner respectfully disagrees. Borelli clearly teaches selecting services based on host information ([0038]) and instituting provisioning actions at the device level to provision the user ([0070]).

5(b) Applicant Response:

Applicant notes that in this allegation, the Examiner alleges Borelli discloses “selecting services based on host information,” wherein previously, the Examiner alleged the same paragraph (par. 38) of Borelli as disclosing selecting a “service provider” (see, item 1 above). Applicant submits that selecting a “service” and a “service provider” are different, and should

not be equated. Applicant submits paragraph 38 of Borelli does not disclose both “selecting a service” and “selecting a service provider.”

Applicant previously responded that the cited portion of Borelli (paragraph 70) does not disclose how the provisioning occurs. The key sentence in the paragraph explicitly refers to some other section:

[t]he Provision Manager 48 can then institute the necessary provisioning actions at a provider/device level and complete the necessary steps to provision the user with the ISP's and Network provider's networks in the manner **discussed previously**.” (Emphasis added.)

Applicant maintains, as previously stated in the prior Response, that the above text only states the steps occur as “discussed previously.” Applicant responded that the above text in paragraph 70 does not disclose the limitations in claim 107, including: “host file(s),” nor “generating a host-specific configuration message based on a host protocol file.”

In the present Final Office Action, the Examiner again alleges these limitations are found in paragraph 70 (Final OA, p. 8). Clearly, paragraph 70 does not disclose the words “host type,” “host protocol file,” “host file,” as well as how the limitations relate to each other. Applicant has no way of knowing what aspects of paragraph 70 or what aspects “discussed previously” in paragraphs 1-69 of Borelli correspond to these limitations because the rejection does not explicitly identify these.

Applicant submits that under MPEP 2142 a prima facie case of obvious has not been established, it has not been demonstrated that “all the claim limitations must be taught or suggest by the prior art.” (MPEP 2143.03). Further, because the Examiner has not clearly articulated why Borelli discloses this aspect, Applicant is now facing a “Final Rejection” without being able to effectively rebut the rejection (“It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” MPEP 706.02(j).)

6(a) The Office Action states

In response to applicant's arguments
(Remarks pg. 46 para. 4 to pg. 50 para. 2) please
refer to the above comments as well as the detailed
rejection below.

6(b) Applicant Response:

Applicant provided detailed reasons why claims 108, 113, 114, 121-124 are distinguishable over the prior art.

Because these claims recite additional dependent limitations, the statement "refer to the above comments" cannot be applicable. Specifically, because the dependent claims recite further limitations than found in the independent claims, the reasoning for rejecting the independent claim would not cover limitations found in the dependent claims.

The Office Action also states "please refer to the ... detail rejection below." In this case, **as well as the prior office action**, the Office Action states in the detailed rejection:

"Consider claim 108; see claim 107.

"Consider claim 113; see claim 107.

"Consider claim 114; see claim 107.

"Consider claim 121; see claim 40.

Applicant provided detailed reasons why claims 108, 113, 114 and 121 were distinct from the prior art in response to the prior Office Action, and reiterates them by incorporation by reference. In response, the Examiner has not addressed the arguments submitted by Applicant, and instead refers to the reasoning for rejecting the independent claims. As note above, the reasoning for rejecting an independent claim does not address the limitations in dependent claims. Applicant submits that a prima-facie case of obviousness has not been maintained, and requests the rejection be withdrawn.

SUMMARY

Applicant submits that the rejections in the prior Office Action are insufficient to create a prima-facie case of obviousness. Applicant has shown why certain limitations are not present in the prior art, and has rebutted various rejections in the prior Response, but which were not addressed in the prior Office Action. Applicant respectfully requests the rejection be withdrawn, and the claims be placed in a condition of allowance.

CONCLUSION

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

/Karl H. Koster/

Karl H. Koster
Registration No. 50,684

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON May 8, 2009.